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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,430	06/20/2000	Paul Norman Burgess	Burgess-2-2	6127

7590

04/22/2004

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EXAMINER
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FOX, JAMAL A

ART UNIT	PAPER NUMBER
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2664

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DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/597,430	<b>Applicant(s)</b> BURGESS ET AL.	
	<b>Examiner</b> Jamal A Fox	<b>Art Unit</b> 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 7-17 is/are rejected.
- 7) ☐ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____ |
|---|--|

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 7 and 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Baum et al. (U.S. Patent No. 5,841,842).

Referring to claim 1, Baum et al. discloses a method for generating data for a data network (col. 7 lines 35 – 54) with a telecommunications switch (Fig. 1 reference sign 50, here the telephone company network switches from analog to digital), the method comprising the steps of:

A) receiving a telephone call (col. 7 line 35-40, col. 7 line 65 – col. 8 line 6, here it is understood that the server receives the call);

B) determining with the telecommunications switch (Fig. 1, Network Access Server 30) whether the telephone call includes a first data transmission conforming to a predetermined data protocol, the first data transmission including a first digital information signal (col. 8 lines 12-19, here the control signals are used to identify the predetermined protocol); if the telephone call includes the first data transmission conforming to the predetermined data protocol, then:

C) terminating the predetermined data protocol with the telecommunications switch (Fig. 1, Network Access Server 30 and col. 7 line 65 - col. 8 line 10; here the analog to digital conversion is the termination of the protocol); and

D) demodulating the first digital information signal from the first data transmission (col. 8 line 67 – col. 9 line 3).

Referring to claim 2, Baum et al. discloses the method of claim 1 further comprising the step of:

E) generating a transmit packet that includes the first digital information signal col. 7 line 65 – col. 8 line 6, here the transmit packet is digitized).

Referring to claim 3, Baum et al. discloses the method of claim 2 further comprising the step of: F) transmitting the transmit packet into the data network (network 52, col. 8 lines 39-50).

Referring to claim 5, Baum et al. discloses the method of claim 1 further comprising the steps of :

E) receiving a receive packet from the data network, the receive packet including a second digital information signal (col. 7 lines 35 – 54, here it is inherent that since there is a plurality of phone calls, there has to be a plurality of digital information signals, see Fig. 1, reference sign 22 and respective portions of the specification);

F) modulating the second digital information signal into a second data transmission conforming to the predetermined data protocol (col. 7 lines 44-46); and

G) transmitting the second data transmission in the telephone call (col. 7 lines 44-46, here it is understood that since the data transmission is sent to the telephone line, then it has to be in the telephone call).

Referring to claim 7, Baum et al. discloses the method of claim 1 wherein a digital signal processor analyzes the telephone call to determine whether the first data transmission conforms to the predetermined data protocol (col. 8 lines 12-38, here the central office is the digital signal processor).

Referring to claim 9, Baum et al. discloses the method of claim 1 wherein the step of determining whether the telephone call is the first data transmission comprises determining whether one of a called number and calling number for the telephone call is a predetermined number indicating a data call (col. 5 lines 29-33).

Referring to claim 10, Baum et al. discloses the method of claim 1 further comprising the steps of: if the telephone call includes the first data transmission conforming to the predetermined data protocol, then:

E) translating a called number for the telephone call into a data network indicator; and (col. 8 lines 12-38)

F) establishing a first data connection to a data network based on the data network indicator (col. 21 lines 46-65).

Referring to claim 11, Baum et al. discloses the method of claim 10 further comprising the step of:

G) generating a transmit packet that includes the first digital information signal (col. 8 lines 39-57).

Referring to claim 12, Baum et al. discloses the method of claim 11 further comprising the step of:

H) transmitting the transmit packet into the data network (col. 8 lines 39-57, here the data network is the local area network such as a Token ring).

Referring to claim 13, Baum et al. discloses the method of claim 10 further comprising the steps of:

G) receiving a receive packet from the data network, the receive packet including a second digital information signal (col. 7 lines 35 – 54, here it is inherent that since there is a plurality of phone calls, there has to be a plurality of digital information signals, see Fig. 1, reference sign 22 and respective portions of the specification);

H) modulating the second digital information signal into a second data transmission conforming to the predetermined data protocol (col. 7 lines 44-46);

I) transmitting the second data transmission in the telephone call (col. 7 lines 44-46, here it is understood that since the data transmission is sent to the telephone line, then it has to be in the telephone call).

Referring to claim 14, Baum et al. discloses a telecommunications switching system comprising: an access circuit integral with the telecommunications switching system that receives telephone calls (Fig. 1, reference sign T1; here it is understood that the T1 is an access circuit integral with the telecommunications switching system, col. 8 lines 1-11); a data protocol analyzer (Fig. 1, reference sign Network Access Server 30) coupled to the access circuit to determine whether telephone calls received from the access circuit include a first data transmission conforming to a predetermined

data protocol (col. 8 lines 39-50, see correlating the control signals to the proper protocol parameters associated with each incoming call), the first data transmission including a first digital information signal (col. 8 lines 39-50, see digital signals); a data protocol terminator coupled to the access circuit to terminate the predetermined data protocol (Fig. 1, reference sign 50 and respective portions of the specification); and a demodulator (col. 8 line 67 – col. 9 line 3, here it is understood that the modems are the demodulators) coupled to the access circuit to demodulate the first digital information signal from the first data transmission.

Referring to claim 15, Baum et al. discloses the system of claim 14 further comprising a data network interface coupled to the demodulator that generates a transmit packet that includes the first digital information signal (col. 9 lines 13-20, here it is understood that the modem network interface module is the data network interface).

Referring to claim 16, Baum et al. discloses the system of claim 15 wherein the data network interface receives a receive packet from a data network coupled to the data network interface, the receive packet including a second digital information signal (col. 10 lines 9-14, this is inherent because if there are 24, there has to be a 2<sup>nd</sup>).

Referring to claim 17, Baum et al. discloses the system of claim 16 further comprising: a modulator (col. 7 lines 44-46, here the modem is the modulator) coupled to the data network interface that generates a second data transmission conforming to the predetermined data protocol, the second data transmission including the second digital information signal (this is inherent because each modem has network interface modules capable of multiple data transmissions).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al.

Referring to claim 8, Baum et al. discloses the method of claim 1 wherein the predetermined data protocol is one of a modem (see col. 7 lines 35-54), but does not explicitly teach of the data protocol being one of a facsimile protocol. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included a predetermined data protocol being one of a facsimile protocol because the modems are configured to be compatible with any communication protocol of the call originator. Therefore if the call originator was a facsimile protocol the modems are reconfigured according to the facsimile protocol.

***Allowable Subject Matter***

5. Claims 4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed 02/02/2004 have been fully considered but they are not persuasive. The applicant argued that Baum et al. does not teach or suggest the



claimed step of "determining with the telecommunications switch whether the telephone call includes a first data transmission conforming to a predetermined protocol."

However, one skilled in the art would recognize that a network access server is a telecommunications switch. A switch extracts routing instructions. The network access server extracts control signals from incoming communications, and correlates the control signals to the proper protocol parameters associated with each incoming call (col. 8 lines 41-51).

The applicant argued that Baum et al. does not teach or suggest the claimed step of "terminating the predetermined data protocol with the telecommunications switch." However, one skilled in the art would recognize that the analog to digital conversion is the termination of a predetermined data protocol (see Fig. 1, ref. sign 50).

The applicant argued that Baum et al. does not teach or suggest the claimed "access circuit integral with the telecommunications switching system that receives telephone calls." However, one skilled in the art would recognize that the T1 is an access circuit integral with the telecommunications switching system, col. 8 lines 1-11 and Fig. 1 ref. sign T1.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**8. Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications; please mark  
"EXPEDITED PROCEDURE")

**Or:**

(703) 308-5403 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA. 22202, Sixth Floor

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamal A Fox whose telephone number is (703) 305-5741. The examiner can normally be reached on 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (703) 305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J.A.F.

Jamal A. Fox

A handwritten signature in black ink, appearing to read 'W. Chin', followed by a horizontal line.

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SUPERVISORY PATENT EXAMINER  
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